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In re application of :  
Clemens Schmick et al. : **DECISION ON**  
Serial No. 09/785,508 : **PETITION**  
Filed: February 20, 2001 :  
For: APPARATUS FOR TRANSPORTING STREAMS OF TOBACCO PARTICLES AND THE  
LIKE

This is a decision on the PETITION UNDER 37 CFR 1.181 TO WITHDRAW THE FINALITY OF THE OFFICE ACTION mailed May 6, 2003.

On November 18, 2002, a non-final office action was mailed to applicants rejecting various claims and objecting to other claims as being dependent on a rejected base claim. A reply to the office action was filed by Applicant on February 19, 2003. In the reply, Applicant made several amendments to the claims. One of these amendments was to cancel originally filed claims 1 and 8 and present new independent claim 22 which incorporated the two previous claims into a single independent claim. On May 6, 2003, a final office action was mailed.

On May 13, 2003 the instant petition under 37 CFR 1.181 was filed to formally request the withdrawal of finality of the May 6, 2003 office action.

Applicants position for the withdrawal of the finality is that the new grounds of rejection in the final office action were not necessitated by Applicant's amendments to the claims.

## DECISION

Section 706.07 of the MPEP states:

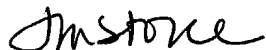
706.07(a) Final Rejection, When Proper on Second Action

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

Petitioner argues that because newly presented claim 22 was merely previous claim 8 rewritten in independent form, the new grounds of rejection applied by the examiner to this claim and then made final were improper. This argument is persuasive. Claim 8 was originally rejected over Garthaffner et al. (US Patent No. 4,817,638) in the office action of November 18, 2002. Claim 22 was then rejected over Garthaffner et al. in view of Crowder and over Korber (GB 919,150) in view of Crowder in the final office action mailed May 6, 2003. The amendment did not require the new grounds of rejection in the final office action.

Because the rejection of claim 22 based on a new ground of rejection was improper, the finality of the office action was premature. Accordingly, the petition for withdrawal of finality is **GRANTED**.

It is also pointed out that while the finality of the office action has been withdrawn, the rejection still stands. It is also noted that Applicants filed a timely amendment on August 5, 2003. This amendment will be treated as an amendment after a non-final office action and will be entered. The application is being forwarded to the Examiner for consideration of said amendment and appropriate action thereon.



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